

REMARKS

Claims 1-23 were pending in this application.

Claims 1-23 have been rejected.

Claims 4, 12 and 20 have been amended to correct a typographical error.

Claims 1-23 remain pending in this application.

Reconsideration and full allowance of all pending claims are respectfully requested.

I. INFORMATION DISCLOSURE STATEMENT

The Office Action states that the Applicants failed to provide copies of all materials cited in the July 27, 2000 IDS and the Sept. 28, 2001 IDS, and requests the Applicants to provide such copies. However, the Sept. 28, 2001 IDS is related to another application (U.S. Patent Application Serial No. 09/627,237 to William R. Caid et al.). Therefore, Applicant is unable to properly discern which materials are missing, and respectfully requests the Examiner to clearly list the materials that are needed to comply with 37 CFR 1.98(a)(2).

II. OBJECTIONS TO CLAIMS AND SPECIFICATION

The Office Action objects to Claims 4, 12 and 20 and page 7, lines 14-15 of the specification because of they fail to correctly disclose where the first feedback signal is generated. The Examiner requests that the claims and specification be amended to state "said first feedback signal from said first feedback ~~signal~~ filter to produce a combined output." Applicants have amended Claims 4, 12

and 20 and page 7, lines 14-15 of the specification, in accordance with the Examiner's request. Therefore, Applicants respectfully request the withdrawal of the objection to Claims 4, 12 and 20 and page 7, lines 14-15 of the specification.

III. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1-5, 8-13 and 16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Number 6,031,866 to Oler et al. ("*Oler*"). Claims 17-23 were also rejected under 35 U.S.C. § 102(e) as being anticipated by *Oler*. These rejections are respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

The Office Action provides a summary of *Oler* on pages 3-4. However, the Office Action fails to show where each and every element of the presently claimed invention is found in *Oler*. For example, the Office Action fails to show where "a known symbol generator capable of generating a copy of a first known symbol prior to an estimation of said first known symbol by said decision feedback equalizer, wherein said decision feedback equalizer uses said copy of said first known

symbol to reduce a first precursor ISI signal in a second symbol transmitted prior to said first known symbol,” as recited in Claim 1 (and similarly recited in Claims 9 and 17) is found in *Oler*.

For at least these reasons, *Oler* fails to anticipate the Applicants’ invention as recited in Claims 1, 9 and 17 (and their dependents). Accordingly, the Applicants respectfully request the withdrawal of the § 102 rejection and full allowance of Claims 1-5, 8-13 and 16-23.

IV. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 6-7 and 14-15 under 35 U.S.C. § 103(a) as being unpatentable over *Oler*. Claims 22 and 23 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oler*. The Office Action further rejects Claims 6-7 and 14-15 under 35 U.S.C. § 103(a) as being unpatentable over *Oler* in view of U.S. Patent Number 5,748,674 to Lim (“*Lim*”). Claims 22 and 23 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oler* in view of *Lim*. These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP §

2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As described above, *Oler* fails to disclose, teach or suggest each and every element recited in Claims 1, 9 and 17. The Office Action does not recite *Lim* as disclosing, teaching or suggesting the elements of Claims 1, 9 and 17, from which Claims 6-7, 14-15 and 22-23 depend, respectively.

As a result, the Office Action fails to establish a *prima facie* case of obviousness against Claims 6-7, 14-15 and 22-23. Accordingly, the Applicants respectfully request the withdrawal of the

§ 103 rejection and full allowance of Claims 6-7, 14-15 and 22-23.

V. CONCLUSION

As a result of the foregoing, the Applicants assert that the claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

SUMMARY


If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: Feb. 19, 2004



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